REMARKS

Claims 1, 2 and 4 are present in the application. Claims 1 and 4 have been amended and are independent. Reconsideration of this application, as amended, is respectfully requested.

Status of the Drawings

A Letter to the Official Draftsperson was submitted to the Examiner for consideration on February 28, 2003. However, the Examiner has not provided any indication as to whether the amendments to the Drawings have been approved. In the Letter to the Official Draftsperson, it was proposed to amend Figure 1 to include reference numerals 2a and 2b to identify the heel and forefoot portions of the outsole respectively.

As the Examiner will note, corrected formal Drawings are attached to the present Amendment for the Examiner's consideration. The corrected formal Drawings include the proposed amendments to the Drawings submitted in the Letter to the Official Draftsperson dated February 28, 2003. **It is respectfully requested that the Examiner approve the corrected formal Drawings in the next Office Communication.**

Rejection Under 35 U.S.C. § 112

Claims 1, 2 and 4 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed.

The Examiner asserts that claims 1 and 4 are indefinite due to the term "including." Applicants submit that the Examiner's rejection is without basis. The term "including" is a commonly used term that is well accepted in the drafting of claims. Specifically, the term "including" is an open-ended transitional phrase that is synonymous with the term "comprising." The Examiner is directed to MPEP § 2111.03, entitled "Transitional Phrases," which states "[t]he transitional phrase 'comprising', which is synonymous with 'including,' 'containing,' or 'characterized by,' is inclusive or open-ended and does not exclude additional unrecited elements or method steps" (emphasis added).

With regard to the Examiner's assertion that the use of symbols is indefinite, and not consistent with U.S. practice, Applicants respectfully submit that the Examiner's position is also without basis. The Examiner is directed to MPEP § 608.01(m), which states:

> Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims."

With regard to the Examiners comments with regard to it being unclear what the symbols correspond to, the Examiner is also incorrect. In each situation where reference characters are used, the reference character is clearly defined. For example, in claim 1, h1 is the projected height of the spike and h2 is the projected height of the projected portion. In view of this, the Examiner's rejection is improper and should be withdrawn.

Although Applicants do not agree with the Examiner, in order to expedite prosecution, claims 1 and 4 have been amended to remove the reference characters that previously appeared in parenthesis in these claims. However, the remaining reference characters have not been removed, but have been provided in parentheses. For the above-mentioned reason, the use of reference characters is completely acceptable under U.S. practice, contrary to the Examiner's assertion. To the extent that the Examiner believes that the use of reference characters is improper, it is requested that the Examiner provide a proper basis for such position.

In view of the above amendments and remarks, Applicant respectfully submits that claims 1, 2 and 4 are definite and clear. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph are respectfully requested.

Rejection Under 35 U.S.C. § 103

Claims 1, 2 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kataoka et al., USPN 5,533,282 in view of Wideman et al., U.S. Patent No. 5,922,792, Norton, U.S. Patent No. 4,559,724 and Murray, U.S. Patent No. 3,977,096. This rejection is respectfully traversed.

The present invention is directed to a shoe, wherein a plurality of recitations is included in independent claims 1 and 4 including "an entirety of said plurality of spikes being made of a molded rubber material" and "said plurality of spikes being removably mounted to said outsole." Applicant submits that the references relied on by the Examiner fail to teach or suggest this aspect of the present invention.

The Examiner asserts that Kataoka et al. discloses all of the elements of independent claims 1 and 4 except for the specific synthetic resin, which is used for the spike. Specifically, the Examiner asserts that the spikes and the plate to which the spikes are attached comprise synthetic resin. The Examiner relies on column 1, lines 12-22 of Kataoka et al. for this position. Applicant submits that Kataoka et al. does not disclose spikes made of synthetic resin, contrary to the Examiner's assertion. Referring to this portion of Kataoka et al., the following is stated:

> A hard plate made of synthetic resin is mounted to a forefoot portion of a sole on each shoe of a pair of spike shoes for field and track events, on an all-weather type track. Eleven spikes of less prescribed, as a general rule for field and track meets, are detachably attached onto a surface side of this hard plate and many projecting portions are integrally formed on this surface side.

> As shown in FIG. 1, a surface 20a of a hard plate 20 of this type is normally formed approximately in a flat shape. Spike attaching portions 30 are projected and formed by the same material as this surface 20a as a reference face. (emphasis added).

As can be clearly understood from the above, the hard plate 20 and the spike attaching portions 30 are made of synthetic resin. However, there is no disclosure in the Kataoka et al. reference with regard to the material of the spikes 9. Referring to Figure 1 of Kataoka et al., the spikes 9 are the elements that are "removably mounted to the outsole" as required by independent claims 1 and 4 of the present invention. Therefore, it is necessary for the spikes 9 and not the hard plate 20 and the spike attaching portions 30 to be made of molded rubber, since claims 1 and 4 recite "an entirety of said plurality of spikes being made of a molded rubber material" and "said plurality of spikes being removably mounted to said outsole." Since the hard plate 20 and the spike attaching portions 30 are not "removably mounted to the outsole," the Kataoka et al. reference fails to disclose spikes being made of synthetic resin material.

With regard to the Examiner's reliance on the Murray, Wideman et al. and Norton references, these references also fail to disclose the use of a synthetic rubber material for a removably mounted spike as required by independent claims 1 and 4 of the present invention. Accordingly, these references fail to make up for the deficiencies of Kataoka et al. In addition, the Examiner has failed to provide any teaching of the provision of soft, removable spikes of any kind on a shoe. Accordingly, the prior art clearly fails to disclose the inventive aspects of the present invention.

With specific regard to the Examiner's modification of Katoaka et al. in view of the Murray reference, Applicants submit that this modification is contrary to the teachings of Kataoka et al. and therefore non-obvious. Kataoka et al. is directed to shoes for track and field events. Shoes for track and field events do not include spikes on the heel portion of the shoes. In view of this, the Examiner's modification of Kataoka et al. in view of Murray to include spikes on the heel portion of the Kataoka et al. shoe would destroy the intended operation of the track shoes of Kataoka et al.

It is noted that Murray states that the shoes can be used for baseball and track and that the spikes can be located on the heel, forefoot, or both. However, Applicant submits that the embodiment of Murray, where the spikes are on the heel are for baseball and not track. If the shoes of Murray are used for track, there would be no spikes on the heel portion of the shoe.

With regard to the Examiner's reliance on Wideman et al., Applicant respectfully submits that the Examiner's modification of the Kataoka et al. reference is improper. The Examiner relies on Wideman et al. to teach the specific synthetic resin. However, as mentioned above, Kataoka et al. fails to disclose the use of any type of synthetic resin for the spikes 9. Since there is no indication in Kataoka et al. that the spikes 9 are made from a synthetic resin material, Applicant respectfully submits that one having ordinary skill in the art would not be motivated to modify the Kataoka et al. spike in view of the Wideman et al. teaching as asserted by the Examiner.

Specifically, since the shoe of Kataoka et al. is used for track and field events, Applicant respectfully submits that the spikes 9 are made of a very hard material such as metal. The reason for this is that conventional spikes used for track and field events are made of hard materials. Since the synthetic resin material of Wideman et al. is a soft material, one having ordinary skill in the art would not be motivated to use the material of Wideman et al. to construct the spike 9 of Kataoka et al. Referring to column 8, lines 21-31 of Wideman et al., for example, the material of Wideman et al. is used to form tires, belts, hoses, etc. Referring to claim 9 of Wideman et al. it is also indicated that rubber shoe heels and soles can be constructed of this material. Although this is more related to the Kataoka et al. invention, it clearly indicates that the material is used only for "rubber" shoe heels and soles and therefore the material is clearly a soft material which would be much softer than the spikes 9 of Kataoka et al.

In view of the above, Applicant respectfully submits that the modification proposed by the Examiner is unreasonable. The Examiner has provided absolutely no suggestion to provide soft spikes in the Kataoka et al. shoe. Accordingly, the Examiner's rejection should be withdrawn.

It should also be noted that the Examiner relies on the Norton reference for the teaching that spikes of a shoe sole are known to be formed from a synthetic resin having a lower hardness than a remainder of the sole. Applicant respectfully submits that Norton does not teach what the Examiner indicates is being teached. The cleats of Norton are not spikes. The cleats of Norton would be equivalent to the ground contact

portions 11 of the present invention and the spike attaching portions 30 which include projecting portions 40 formed integrally therewith (See Fig. 1 of Kataoka et al.). This can be clearly understood due to the fact that Norton also discloses removable spikes, which appear to be made up of a metal material. The spikes are attached to spikes fasteners 48A-48F. In order for Norton et al. to disclose what the Examiner asserts is disclosed by Norton, it would be necessary for the spikes, which would be attachable to the spike fasteners 48A-48F, to be made of a synthetic resin material. Since the Norton reference fails to disclose spikes made of a synthetic resin material, Applicant respectfully submits that the Norton reference fails to make up for the deficiencies of Kataoka et al., Murray and Wideman et al.

With regard to the Wideman et al. references itself, to the extent that the Examiner's modification of the Kataoka et al. reference is proper, a fact which Applicant does not agree with, Applicant respectfully submits that the material of Wideman et al. fails to teach a JIS-C hardness in the range of from 35-95 as recited by the independent claims of the present invention. The Examiner recognizes that Wideman et al. teaches a hardness of 50.5 shore hardness. Applicant respectfully submits that the shore hardness of 50.5 is outside the range of hardness recited in the independent claims of the present invention. A JIS-C hardness of from 35-95 is converted to shore hardness of from 70-100. Namely, a hardness of 50.5 (shore hardness; column 10, lines 25-48 in Wideman et al.) is not within the range of 35-90 JIS-C hardness. It would be necessary

for Wideman et al. teach a shore hardness of from 70-100 in order to be within the claimed range.

In view of the above, none of the references relied on by the Examiner teach the hardness recited in the independent claims of the present invention. Accordingly, the Examiner's rejection under 35 U.S.C. § 103 is improper and should be withdrawn for this additional reason.

Referring to page 5, first full paragraph of the Examiner's Office Action, the Examiner states "the hardness would be readily determined through routine optimization by one having ordinary skill in the art depending on the desire and use of the product." Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness in the present case. In order to establish a *prima facie* case of obviousness, the Examiner must set forth some rationale or suggestion of why it would be obvious to modify a reference in a particular manner. In the present case, the Examiner has provided absolutely no reason to modify the combination of Kataoka et al., Murray, Wideman et al. and Norton in the manner asserted by the Examiner. Accordingly, the Examiner's rejection is improper and should be withdrawn.

As mentioned above, Applicant respectfully submits that one having ordinary skill in the art would not be motivated to modify the Kataoka et al. reference in view of the Wideman et al. reference, since the Wideman et al. reference teaches a very soft material, while Kataoka et al. teaches very hard material for the spikes 9. Since there is no teaching provided by the Examiner to provide Kataoka et al. with a soft spike, one

having ordinary skill in the art would not modify the Kataoka et al. shoe as proposed. The Examiner cites the *In re Boesch and Slaney* case for the proposition that it would have been obvious to vary the hardness since the hardness would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Wideman et al. The Examiner's reliance on this case is not applicable in the present situation. The Examiner still relies on the Wideman et al. reference as a teaching to construct the spikes of Kataoka et al. having a hardness within the range recited in the independent claims of the present invention. However, since Kataoka et al. does not disclose a spike made up of a synthetic resin material and the Wideman et al. reference does not disclose a hardness within the range recited in the independent claims of the present invention, the Examiner has not established a *prima facie* case of obviousness. Specifically, Wideman et al. discloses a hardness outside of the claimed range. In view of this, any modification of the combination of Kataoka et al. and Wideman et al. would be contrary to the teachings of Wideman et al. and therefore non-obvious.

In addition, independent claims 1 and 4 recite "a difference between a hardness (C1) of the ground contact portion of the spike and a hardness(C2) of the projected portion is in the range from 5-80." Applicant respectfully submits that the references relied on by the Examiner also fail to teach or suggest this aspect of the present invention.

Referring to page 13, last paragraph through page 14, first paragraph of the present specification, setting the difference in hardness in the range from 5-80 is advantageous in order to prevent the golfer's foot from slipping on grass and hard ground and to prevent the spike from wearing and chipping. Since the references relied on by the Examiner fail to teach this aspect of the present invention, it is respectfully submitted that the Examiner's rejection is improper and should be withdrawn for this reason as well.

Referring to the Examiner's Office Action at page 5, last paragraph, the Examiner indicates that routine optimization would be used to arrive at the present invention. Applicant respectfully submits that the Examiner has also not established a *prima facie* case of obviousness with regard to this modification of the Kataoka et al. reference as well. The hardness difference disclosed by Norton is not within the range recited by the independent claims. Therefore, Norton teaches away from the claimed invention.

With regard to dependent claim 2, Applicant respectfully submits that this claim is allowable due to its dependence upon allowable independent claim 1, as well as for the additional limitations recited by this claims.

In view of the above amendments and remarks, Applicant respectfully submits that claims 1, 2 and 4 clearly define the present invention over the references relied on by the Examiner. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103 are respectfully requested.

CONCLUSION

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently pending rejections and that they be withdrawn.

It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

In the event there are any matters remaining in this application, the Examiner is invited to contact Paul C. Lewis, Registration No. 43,368 at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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